



Patent
Attorney's Docket No. 005950-753

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Dennis J. O'Rear et al.

Group Art Unit: 1764

Application No.: 10/034,241

Examiner: Thuan D. Dang

Filed: December 28, 2001

Confirmation No.: 9990

For: Improved Conversion of Syngas to Distillate
Fuels

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RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In complete response to the Restriction Requirement set forth in the Office Action dated June 20, 2003, Applicants submit the following response.

In the Office Action, the Examiner sets forth a restriction requirement among two groups of claims:

- I. Claims 1-10, drawn to a process of making isoparaffinic hydrocarbons, classified in class 585, subclass 329.
- II. Claims 11-34, drawn to a process of making fuel, classified in class 208, subclass 17.

Applicants respectfully traverse the restriction requirement as set forth in the Office Action. Applicants respectfully assert that the inventions of Group I and Group II should properly be examined together. The invention of Group I is directed to a process for preparing iso-olefins. The invention of Group II is directed to a process for preparing a distillate fuel comprising iso-olefins. In the process of preparing the distillate fuel, the iso-olefins are prepared. Therefore, the inventions of Group I and Group II are related.

The Examiner contends that the inventions of Group I and Group II are patentably distinct because they produce different products, and therefore cannot be related.

Applicants respectfully assert that the inventions of Groups I and II are closely related and that a proper search of any of the claims should, by necessity, require a proper search of the others. Thus, Applicants submit that all of the claims can be searched simultaneously, and that a duplicative search, with possibly inconsistent results, may occur if the restriction requirement is maintained.

Applicants submit that any nominal burden placed upon the Examiner to search accordingly to determine the art relevant to Applicants' overall invention is significantly outweighed by the public's interest in not having to obtain and study many separate patents in order to have available all of the issued patent claims covering Applicants' invention. The alternative is to proceed with the filing of multiple applications, each consisting of generally the same disclosure, and each being subjected to essentially the same search, perhaps by different Examiners on different occasions. This process would place an unnecessary burden on both the Patent and Trademark Office and on the Applicants.

Regardless of whether the two inventions are independent or distinct, Applicants respectfully assert that the Examiner need not have restricted the application. MPEP § 803 requires that "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Therefore, it is not mandatory to make a restriction requirement in all situations where it would be deemed proper.

In the interest of economy, for the Office, for the public-at-large, and for Applicants, reconsideration and withdrawal of the restriction requirement are requested.

Nevertheless, in order to comply with the requirements of 37 C.F.R. § 1.143, Applicants provisionally elect, with traverse, to prosecute the invention of Group I, namely claims 1-10, for prosecution in the above-identified application.

Applicants have no intention of abandoning any non-elected subject matter and expressly reserve the right to file one or more continuation and/or divisional applications directed to the non-elected subject matter.

The Examiner is invited to contact the undersigned at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted,

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